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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,364	05/31/2001	Barry E. Willner	I01.038	1751
48175	7590	04/21/2005	EXAMINER	
BMT/IBM FIVE ELM STREET NEW CANAAN, CT 06840			DINH, KHANH Q	
			ART UNIT	PAPER NUMBER
			2151	

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/871,364

Applicant(s)

WILLNER ET AL.

Examiner

Khanh Dinh

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,11-16,18-24,27-35 and 37-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,11-16,18-24,27-35 and 37-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This is in response to the Amendment filed on 1/24/2005. Claims 2, 3, 8-10, 17, 25, 26, 36, 41 and 42 are canceled. Claims 1, 4-7, 11-16, 18-24, 27-35 and 37-40 are presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4-7, 11-16, 18-24, 27-35 and 37-40 are rejected under 35

U.S.C. 102(b) as being anticipated by Higley, US pat. No.5,790,793.

As to claim 1, Higley discloses a method of facilitating access with respect to an Uniform Resource Locator (URL) address received via an electronic mail message, wherein the URL address is associated with a Web page and the electronic mail message is associated with an original e-mail address, comprising:

receiving the electronic mail message and determining that the URL address is received via the electronic mail message, associating the URL address with at least one of: (i) the electronic mail message, or (ii) the originating e-mail address (using mail server to process email message including URL, see abstract, figs. 3, 4, col.5 lines 1-41), wherein the associating at least comprises:

displaying an indication of the URL address in association with an indication of at least one of: i) the electronic mail message. or (ii) the originating e-mail address (see col.5 lines 19-53); and

storing the URL address in a manner that indicates that URL address was at least one-of: (i) received via the electronic mail message. or (ii) received from the originating e-mail address (see col.5 line 54 to col.6 line 63 and col.7 lines 38-61).

As to claim 4, Higley discloses an indication of the electronic message and an URL address icon displayed proximate to the indication of the electronic message in a list of electronic mail message indications (see fig.6, col.7 line 37 to col.8 line 49).

As to claims 5 and 6, Higley discloses the activation of the URL address icon results in display of at least one of: (i) the URL information address, or (ii) the web page and further discloses a message icon displayed proximate to the indication of the URL address in a list of information URL address indications (see fig.6, col. 6 lines 16-57 and col.7 line 37 to col.8 line 49).

As to claim 7, Higley discloses wherein activation of the message icon results in display of at least one of: (i) the email address, or (ii) the electronic mail message (see fig.6, col. 6 lines 16-57 and col.7 line 37 to col.8 line 49).

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As to claims 11 and 12, Higley discloses determining metadata associated with at least one of: (i) the electronic mail message, or (ii) the Web page, wherein said storing is performed in accordance with the metadata and the metadata is associated with at least one of: (i) hypertext markup language information, (ii) extensible markup language information, (iii) bookmark exchange language information, (iv) keyword information, (v) category information, (vi) third-party information, (vii) rating information, (viii) quantity information, (ix) date information, (x) an information source, and (xi) a plurality of metadata types (see fig.6, col. 6 lines 16-57 and col.7 line 37 to col.8 line 49).

As to claims 13-15, Higley discloses the information is stored in a directory structure in accordance with the metadata, wherein a plurality of URL addresses are associated with the indication of the electronic mail message and associated with the indication of the URL information address (see fig.6, col. 6 lines 16-57 and col.7 line 37 to col.8 line 49).

As to claim 16, Higley discloses associating is performed by at least one of: (i) a user device, (ii) a personal computer, (iii) a portable computing device, (iv) a personal digital assistant, and (v) a wireless telephone (see fig.6, col. 6 lines 16-57 and col.7 line 37 to col.8 line 49 and col.8 lines 15-62).

As to claim 18, Higley discloses determining at least one of: (i) whether the URL address will be stored, (ii) how long URL address will be stored, (iii) a device at which information will be stored, (iv) whether URL address will be deleted, (v) whether URL address will be replaced, and (vi) whether another electronic mail message will be generated (see fig.6, col. 6 lines 16-57 and col.7 line 37 to col.8 line 49 and col.8 lines 15-62).

Claim 19 is rejected for the same reasons set forth in claim 1.

As to claims 20 and 21, Higley discloses said storage device further stores at least one of: (i) an electronic message database, (ii) an information address database, (iii) a user preference database, and (iv) a pre-determined rule database adapted to communicate with at least one of: (i) an information server, (ii) another user device, (iii) a third-party device, and (iv) a payment device (see figs.5, 6, col. 6 lines 16-57 and col.7 line 37 to col.8 line 49 and col.8 lines 15-62).

Claim 22 is rejected for the same reasons set forth in claim 1.

As to claim 23, Higley discloses a computer-implemented method of facilitating access to a Web page, comprising:

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receiving an e-mail message including a uniform resource locator address associated with the Web page and determining metadata associated with at least one of: (i) the e-mail message, and (ii) the Web page (using mail server to process email message including URL, see abstract, figs. 3, 4, col.5 lines 1-41), storing the uniform resource locator address in a directory structure in accordance with the metadata and storing with the uniform resource locator address an indication associated with the e-mail message (see col.5 line 54 to col.6 line 63 and col.7 lines 38-61).

As to claim 24, Higley discloses a method of facilitating storage of an URL address associated with a Web page stored at an information server (302 fig.3), comprising:

receiving an email message and extracting the URL address from the email message (using mail server to process email message including URL, see abstract, figs. 3, 4, col.5 lines 1-41); and

determining metadata associated with Web page and determining at a user device remote from the web server whether the URL address will be stored, wherein the determining is based at least in part on the metadata (see col.5 line 54 to col.6 line 63 and col.7 lines 38-61).

Claim 27 is rejected for the same reasons set forth in claim 12.

As to claims 28 and 29, Higley discloses determining the metadata comprises at least one of: (i) receiving the metadata from the web server, (ii) evaluating the web page, and (iii) receiving the metadata from a third-party and the URL address will be stored is further based on at least one of: (i) a pre-determined rule, or (ii) a user preference (see figs.5, 6, col. 6 lines 16-57 and col.7 line 37 to col.8 line 49 and col.8 lines 15-62).

As to claims 30-33, Higley discloses storing the URL address at the user device, performed in accordance with the metadata, stored in a directory structure in accordance with the metadata and storing the metadata at the user device (see figs.5, 6, col. 6 lines 16-57 and col.7 line 37 to col.8 line 49 and col.8 lines 15-62).

As to claim 34, Higley discloses determining, based on the metadata, at least one of: (i) how long the URL address will be stored, (ii) a device at which the URL address will be stored, (iii) whether the URL address will be deleted from the user device, (iv) whether another URL address will be deleted from the user device, (v) whether another URL address will be replaced by the information address at the user device, and (vi) whether an e-mail message will be generated (see figs.5, 6, col. 6 lines 16-57 and col.7 line 37 to col.8 line 49 and col.8 lines 15-62).

Claim 35 is rejected for the same reasons set forth in claim 16.

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Claims 37-40 are rejected for the same reasons set forth in claims 19-21 and 24 respectively.

Response to Arguments

4. Applicant's arguments with respect to claims 1, 4-7, 11-16, 18-24, 27-35 and 37-40 have been considered but are moot in view of the new ground(s) of rejection.

Other prior art cited

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Higley, US pat. No.6,065,048.
- b. Gilmour, U.S. pat. No.6,205,472.

Conclusion

6. Claims 1, 4-7, 11-16, 18-24, 27-35 and 37-40 are rejected.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dinh whose telephone number is (571) 272-3936. The examiner can normally be reached on Monday through Friday from 8:00 A.m. to 5:00 P.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung, can be reached on (571) 272-3939. The fax phone number for this group is (703) 872-9306.

A shortened statutory period for reply is set to expire THREE months from the mailing date of this communication. Failure to response within the period for response will cause the application to become abandoned (35 U. S. C . Sect. 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(A).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval IPAIRI system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Khanh Dinh
Patent Examiner
Art Unit 2151
4/15/2005